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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,525	06/28/2001	John D. Barnard	2908.P3	4923

5514 7590 07/13/2005

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NEW YORK, NY 10112

EXAMINER

JAROENCHONWANIT, BUNJOB

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Supplemental
Office Action Summary

Application No.

09/892,525

Applicant(s)

BARNARD ET AL.

Examiner

Bunjob Jaroenchonwanit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 14-39, 42-67, 70-95 and 98-112 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14-39, 42-67, 70-95 and 98-112 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/15/01 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. In response to the request for new office action filed 05/27/05, because the Office Action mailed 05/12/05, contains errors. Since the errors are brought to the Office's Attention within one month, and applicant requested the error to be corrected and the correction for clarification is necessary. The shorten statutory time period set forth in the previous Office Action, is hereby restart from the mailing date of this Office Action (MPEP 710.06).

2. In response to the amendment filed 03/01/05, the amendment has been considered. Claims 12, 13, 40, 41, 68, 69, 96 and 97 were cancelled. Claims 1-11, 14-39, 42-67, 70-95 and 98-112 are pending for examination and amended to include a feature of accessing user-configurable parameters and publishing print queue in accordance with the user-configurable parameters. Newly rejection are as stated below.

Information Disclosure Statement

3. Applicant is reminded that applicant has declared that applicant had acknowledged the duty to disclose information, which is material to patentability as defined in 37 CFR § 1.56. In this instance, applicant failed to disclose the co-pending application 09/895,021, which filed on the same day by the same representative. Applicant should note that the patentability of the application could have been impeded, if such information had been discovered later in the prosecution or the patent could have been invalidated, if such information had been discovered after the patented application had been patented.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the features "accessing user-configurable parameters for the print queue; and publishing the print queue to the network

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according to the user configurable parameters”, as claimed must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the features “accessing user-configurable parameters for the print queue; and publishing the print queue to the network according to the user configurable parameters,” as claimed in all, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-11, 14-39, 42-67, 70-95 and 98-112 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

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had possession of the claimed invention. The amended claims recite “user-configurable parameters,” which is new and not taught in the application as originally filed. Thus, the “user-configurable parameters” and its’ functionalities, therefore, are considered new matters. Since the phrases have not been taught or never once mentioned in the original specification, the phrases, therefore, are interpreted as a configuration data related to print queue, as has been previously given.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-11 and 14-28 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: devices or element that performing the method steps as claimed, such omission amounting numerous of questions, which would be unclear whether how the claims’ method steps are being carried on and by which device, in order to manage printing devices.

9. Claims 57-67, 70-95 and 98-112 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: devices or elements that execute computer-executable process steps as claimed, such omission amounting numerous of questions, which would be unclear whether how the process steps are being carried on and by which devices, in order to manage printing devices.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-11, 14-39, 42-67, 70-95 and 98-112 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-184 of copending Application No. 09/895021. Although the conflicting claims are not identical, they are not patentably distinct from each other because Context of the claimed invention in the instant application is analog to the context of the claimed invention in the undeclared co-pending application.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. The text of those sections of Title 35, U.S. Code § 103(a) not included in this action can be found in a prior Office Action.

13. Claims 1-8, 10-11, 14, 19-23, 28-36, 38-39, 42, 47-51 56-64, 66-67, 70, 75-79, 84-92, 94-95, 98, 103-107 and 112 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al (EP 952513, "White", hereinafter) and Richter et al. (US 6,678,068, "Richter," hereinafter).

14. In light of amended claims' suggesting new matter(s), the amended claims recite "user-configurable parameters," which is new and not taught in the application as originally filed.

Thus, the "user-configurable parameters" and its' functionalities, therefore, they are considered as a new matter. Since the phrases have not been taught or never once mentioned in the original disclosure, the phrases' are, therefore, considered and interpreted the same as a configuration data related to print queue, which included printer driver, as has been previously given.

15. Regarding claims 1, 28-29, 56-57, 84-85 and 112, White discloses a method, system and computer programs record in computer readable mediums (a "system" hereinafter), for managing a plurality of printing devices connected on a network, comprising means, steps and instructions for: detecting a printing device connected on the network; requesting information from the detected printing device; receiving the requested information from the printing device; creating a print queue for the printing device based on the received information; accessing user-configurable parameters for the print queue (abstract, Fig.1; ¶3, indicates that users-configurable parameters in fact is prior art to White; ¶8). White is silent on publishing print queue to network. However, publishing print queue, i.e., displaying, announcing, notifying presenting advertising,

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print queue or status of printer, print's queues or print's spool to a client device in a network, was conventional, which had readily been employed long before the instant invention was made.

Evidently, in the same field of endeavor, Richter, clearly teaches the same (see Richter, figures 24-30, and corresponding details Col. 13, line 25 *et seq.*) Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate a publishing-print-queue idea or the like with White, autonomous configurable print queue' system. Because, such combination or modification would enable users to obtain status or printers or prints' queue, and/or locations, availability of printing device from server without having to physically walk to specific printing location(s), thereby increasing user convenience and reducing time unnecessary time consuming, which in turn would improve efficiency of the operation-unit, wholly.

16. Regarding claims 2-8, 10-11, 19-23, 30-36, 38-39, 47-51, 58-64, 66-67, 75-79, 86-92, 94-95, and 103-107, White-Richter discloses the system further includes, detecting an address assignment message sent between an address server and the printing device over the network (White-Richter's system also employs DHCP standard, White teaches printer driver, i.e., type and capability of printer included, is transmitted to printing system, White's ¶ 13, 18).

17. Claims 9, 37, 65 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over White-Richter, as applied to claims (1, 29, 57, 85) above and Clough (US 6,820,124).

18. Regarding claims 9, 37, 65 and 93, White-Richter discloses the invention substantially, as claimed, as described, but it is silent on communication by using SNMP. However, SNMP are standard for communicating message with a network, specifically it has been utilized in particular for communicating message between printer and its host, the aforesaid is evidently taught in Clough. Thus, including a standard that is set forth for specific purpose for functioning

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the same would have been obvious to one of ordinary skilled in the art. Because, adopting SNMP for communication messages, as suggested in Clough, would be a simplistic process of designing system and enhancing system's flexibility, in which ordinary artisan would look for, before reinvent a new way of communication.

19. Claims 14-18, 24-27, 42-46, 52-55, 70-74, 80-83, 98-102 and 108-111 are rejected under 35 U.S.C. 103(a) as being unpatentable over White-Richter, as applied to claims (1, 29, 57 and 85) above and Lee (US 6,628,413).

20. Regarding claims 14-18, 24-27, 42-46, 70-74 and 98-102, White discloses the invention substantially, including configuring IP addresses, print queue name, print server and its capabilities (White's teaching printer acquire IP address using DHCP ¶15; Richter teaches GUI, publishing IP address (266) in figure 24, printer or queue name (124) in figure 25, capabilities (166) in figure 24). White-Richter is silent on including MAC address and printing policy with a configurable parameter. However, MAC address is inherent in network computing device, thus to include the MAC address as a configuration parameter would have been obvious to one having ordinary skill in the art at the time of the invention was made that was a matter of choice, since White-Richter clearly is capable of configuring printing device using IP address as configurable parameter, thus, using other type of address, such as MAC address, would be conceivable to an artisan. In addition, in the same field of endeavor, Lee teaches an inventive concept that uses JAVA programming to create print queue(s) web page(s), which contain(s) a plurality of links representing each of the print queue(s) entries in the print queue(s) configurable database. Further, Lee also teaches that the JAVA printer is widely utilized for publishing printer queue(s) on a web page to enable clients to control printer. Furthermore, Lee teaches

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publishing rules and allowing user or administrator to change rules for controlling printer tasks, e.g., maximum job size, what type or image and to whom the print cost should be allocated, i.e., printing policy (Lee, Fig. 3). Thus associated printer queue with web page is not new, but rather would have been obvious to one of ordinary skill in the art at the time of the invention was made to do so, because it would enable users or administrators to remotely configure or reconfigure or control printers' operation in various applications, including cost control, as suggested in Lee (Col. 4, line 22- Col. 5, line 55 and Fig. 3).

21. Applicant's arguments filed 3/1/05 has been fully considered have been considered but are moot in view of the new ground(s) of rejection.

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

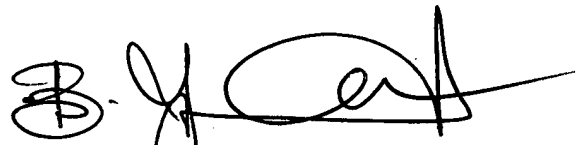
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is (571) 272-3913. The examiner can normally be reached on 8:00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'B. Jaroenchonwanit', with a long horizontal stroke extending to the right.

Bunjob Jaroenchonwanit
Primary Examiner
Art Unit 2143

/bj
7/10/05